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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,989	08/11/2003	Robert Greenberg	S230-USA	6557

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SECOND SIGHT MEDICAL PRODUCTS, INC.
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EXAMINER

DIETRICH, JOSEPH M

ART UNIT

PAPER NUMBER

3762

NOTIFICATION DATE

DELIVERY MODE

06/20/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/638,989

Applicant(s)

GREENBERG ET AL.

Examiner

JOSEPH DIETRICH

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed April 12, 2011, with respect to the rejections of claims 26 – 35 under 35 USC 112, first paragraph have been fully considered and are persuasive. The rejection of claims 26 – 35 under 35 USC 112, first paragraph has been withdrawn.

Applicant's arguments filed April 12, 2011 with respect to the rejection of claims 26 – 35 under 35 USC 103(a) as being unpatentable over Milojevic in view of Sheppard have been fully considered but they are not persuasive.

Applicant argues that Milojevic does not qualify as prior art because it was filed on 11/7/03 and was published as a pending application on 7/29/04. However, Milojevic et al. (US PGPUB 2004/0147825) has a PCT filed dated of May 7, 2002. It is reminded a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent. In the instant case, Milojevic is a 371 application that (1) was filed after November 29, 2000, (2) designated the U.S. and (3) was published in English. Therefore, the 102(e) date of Milojevic is the international filing date of May 7, 2002. Please see MPEP 706.02(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milojevic et al. (US PG PUB 2004/0147825) in view of Sheppard et al. (US PG PUB 2002/0187260).

Regarding **claim 26**, Milojevic discloses choosing a rigid substrate (e.g. 42 and paragraph 52); cleaning said substrate (e.g. paragraph 94 and 248); depositing a first polyparaxylylene layer on the substrate (e.g. paragraph 248); depositing an electrical conductor on the polyparaxylylene layer (e.g. paragraph 90); patterning the conductor to form a conductive path (e.g. paragraph 90). Sheppard teaches it is known to deposit a second polyparaxylylene layer (e.g. paragraph 14) and remove at least a portion of the second layer defining at least one aperture therein (e.g. paragraph 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of depositing a first polyparaxylylene layer as taught by Milojevic with depositing a second polyparaxylylene layer as taught by Sheppard, since such a modification would provide the predictable results of providing further insulation around the conductive wires.

Regarding **claim 27**, Milojevic discloses a substrate, as previously mentioned. Sheppard teaches it is known to choose a substrate comprised of glass (e.g. paragraph 29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the substrate as taught by Milojevic with the glass substrate as taught by Sheppard, since such a modification would provide the predictable results of using a cost-effective readily available substrate.

Regarding **claims 28 – 32**, Milojevic discloses depositing a polyparaxylylene layer, as previously mentioned. Sheppard teaches it is known to apply silane and/or modify the polyparaxylylene layer by chemical means in order to enhance the layer for adhesion (e.g. paragraph 80). It would have been

Art Unit: 3762

obvious to one having ordinary skill in the art at the time the invention was made to modify the depositing of the polyparaxylylene layer as taught by Milojevic with enhancing the layer for adhesion as taught by Sheppard, since such a modification would provide the predictable results of effectively adhering the substrate, polyparaxylylene layers and conductive paths to one another.

Regarding **claims 33 and 34**, Milojevic in view of Sheppard discloses enhancing the polyparaxylylene layer for adhesion, as previously mentioned. Examiner takes official notice that the steps of roughening a layer and compressing two layers thermally are well known methods of enhancing a layer for adhesion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the enhancing of the polyparaxylylene layer as taught by Milojevic in view of Sheppard with enhancing the polyparaxylylene layer using the steps of roughening a layer or compressing two layers thermally as is well known in the art, since such a modification would provide the predictable results of effectively adhering the substrate, polyparaxylylene layers and conductive paths to one another.

Regarding **claim 35**, Milojevic discloses the step of depositing a polyparaxylylene layer, as previously mentioned. Sheppard teaches it is known to remove at least one portion of the second polyparaxylylene layer by etching with reactive ions (e.g. paragraph 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of depositing a first polyparaxylylene layer as taught by Milojevic with depositing a second polyparaxylylene layer and removing portions of that layer by etching as taught by Sheppard, since such a modification would provide the predictable results of providing apertures through which the conductive wires can contact living tissue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

Art Unit: 3762

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH DIETRICH whose telephone number is (571)270-1895. The examiner can normally be reached on M-F, 9:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on 571-272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. D./
Examiner, Art Unit 3762

/Scott Getzow/
Primary Examiner, Art Unit 3762